

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Brian J. Petryna  
Serial No.: 09/940,783  
Filed: August 28, 2001  
For: SYSTEM AND METHOD FOR AUTOMATICALLY ESTABLISHING  
A TELEPHONE CALL OVER A COMPUTER NETWORK  
Grp./A.U.: 2664  
Examiner: Andrew Chung Cheung Lee Confirmation No.: 3916

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

I hereby certify that this correspondence is being electronically filed  
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November 22, 2006 (Date)

Karen Vertz  
(Printed or typed name of person signing the certificate)

/Karen Vertz/  
(Signature of the person signing the certificate)

Sir:

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

The Appellant has carefully considered this application in connection with the Examiner's Final Rejection mailed August 23, 2006, and respectfully requests a pre-appeal brief review of this application in view of the following remarks.

### **REMARKS/ARGUMENTS**

The Appellant originally submitted Claims 1-21 in the application and amended independent Claims 1, 8 and 15. . The Appellant has not canceled or added any claims. Accordingly, Claims 1-21 are currently pending in the application.

#### **I. Rejection of Claims 1-21 under 35 U.S.C. §103**

The Examiner rejected Claims 1-21 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,760,324 to Scott, *et al.*, in view of U.S. Patent No. 6,553,116 to Vander Meiden. As the Reviewers are no doubt aware, “[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation . . . to modify the reference or combine reference teachings. Second, there must be some reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” (*See* MPEP §706.02(j).) It is sufficient to show that a *prima facie* case of obviousness has not been established by showing that only one of the above requirements has not been met.

The Appellant respectfully submits that the cited combination of Scott and Vander Meiden fails to establish a *prima facie* case of obviousness. First, the combined teaching of Scott and Vander Meiden does not teach or suggest each element of independent Claims 1, 8 and 15, including: (1) extracting a destination address for a subsequent telephone call from calling number identification signals received from a circuit-switched telephone network via a first telephone call or (2) employing the destination address to automatically initiate the subsequent telephone call to the destination address via a computer network. Additionally, there is no suggestion or motivation to modify the references or combine the teachings of the references.

The Examiner recognizes that Scott does not teach or suggest extracting a destination address for a subsequent telephone call from calling number identification signals received from a circuit-switched telephone network via a first telephone call. (*See* Examiner’s Final Rejection, page 3.) As such, Scott also

does not teach or suggest employing the extracted destination address to automatically initiate a subsequent telephone call to the destination address. To cure the noted deficiency of Scott, the Examiner cites Vander Meiden. (*See* Examiner's Final Rejection, page 3.)

Vander Meiden is directed to automatically detecting a pending change in an area code or numbering plan area during the period when either a new area code or an existing area code may be used to dial a particular number. (*See* column 1, lines 63-67.) Vander Meiden discloses an originating party using an originating telecommunications device 502 to dial a terminating party user's telephone number. The originating telecommunications device 502 issues a call setup message, including the called party's telephone number, which is received by a switch 503. The switch 503 uses the called party's number, as well as calling party identification information, to direct the call to the called party via the public network 500. The terminating party device 504 issues a call connect message, including the terminating party's telephone number and a new area code if applicable to the originating equipment 502. (*See* column 4, lines 34-57, and Figures 1 and 4.)

The Examiner asserts that Vander Meiden cures the noted deficiency of Scott by disclosing extracting a called or terminating party's telephone number from a received call connect message. (*See* Examiner's Final Rejection, page 3, referring to column 5, lines 17-21 of Vander Meiden.) The called or terminating party's telephone number in Vander Meiden, however, is not a destination address for a subsequent telephone call as asserted by the Examiner. On the contrary, the terminating party's telephone number is the telephone number that was just used to connect the call to the called party. (*See* column 2, lines 1-3; column 4, lines 49-51; column 5, lines 16-20; and column 7, lines 54-61.) Thus, the extracted terminating party's telephone number is not a destination address for a subsequent call but is a telephone number from a call that is already connected. Accordingly, Vander Meiden does not cure this deficiency of Scott.

Additionally, even assuming *arguendo* that the extracted terminating party's telephone number is a destination address for a subsequent call as asserted by the Examiner, the terminating party's telephone number

is not extracted from calling number identification signals received from a circuit-switched telephone network via a first telephone call as presently claimed. On the contrary, the terminating party's telephone number is extracted from a call connect message. (*See* column 4, lines 49-51; column 5, lines 16-20; and column 7, lines 54-58.) Vander Meiden provides no teaching or suggestion that the call connect message is calling number identification signals. Instead, as noted above, Vander Meiden discloses the call connect message is sent from the terminating party device 504 to the originating equipment 502 and includes the connected terminating party's telephone number with the area code.

Furthermore, Vander Meiden provides no teaching or suggestion that the extracted terminating party's telephone number is employed to automatically initiate a subsequent telephone call to the terminating party. Instead, the received telephone number is used to determine if an area code change is pending or to update an area code list. (*See* column 4, lines 51-58; column 5, lines 20-40; and column 7, line 57, to column 8, line 8.) Thus, even if the terminating party's telephone number is a destination address that is extracted from calling number identification signals, the terminating party's telephone number is still not used to automatically initiate a subsequent telephone call to the terminating party's telephone number.

Accordingly, Scott and Vander Meiden, individually or in combination, do not teach or suggest extracting a destination address for a subsequent telephone call from calling number identification signals received from a circuit-switched telephone network via a first telephone call as recited in independent Claims 1, 8 and 15. As such, the combination of Scott and Vander Meiden also does not teach or suggest employing the destination address to automatically initiate the subsequent telephone call to the destination address via a computer network as recited in independent Claims 1, 8 and 15. The cited combination, therefore, fails to teach or suggest each element of independent Claims 1, 8 and 15 and Claims dependent thereon.

The Appellants also do not find a teaching, disclosure or suggestion supporting the combination of Scott and Vander Meiden. On the contrary, while Scott is directed to voice of the Internet technology (*see* column 1, lines 10-11), Vander Meiden relates to automatically detecting pending area code changes and

updating speed dialing lists, routing tables, *etc.*, (*see* column 1, lines 8-11).

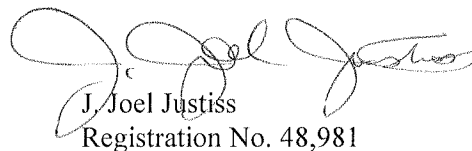
As such, for at least these reasons, the cited combination does not provide a *prima facie* case of obviousness of Claims 1-21 and these Claims are not unpatentable in view thereof. Appellant, therefore, respectfully requests the Review Panel to withdraw the §103 rejection with respect to Claims 1-21 and allow issuance thereof.

## II. Conclusion

In view of the foregoing remarks, Appellant respectfully submits that all of the Claims currently pending in this application are in condition for allowance and therefore earnestly solicits a Notice of Allowance for Claims 1-21. Appellant requests the Reviewers to telephone the undersigned attorney of record at (972) 480-8800 if such would further or expedite the prosecution of the present application. The Commissioner is hereby authorized to charge any fees, credits or overpayments to Deposit Account 08-2395.

Respectfully submitted,

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Dated: November 22, 2006

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